IN THE U.S. PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

APPLICANT: Georg Mayer et al.

SERIAL NO.: 10/581,207   FILING DATE: 9 November 2006

EXAMINER: Timothy X. Pham   ART UNIT: 2617

ATTORNEY'S DOCKET NO.:   800.0105.U1(US)

TITLE: A Method For Handling Service Failures

Mail Stop AF
Commissioner for Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

ARGUMENTS FOR A PRE-APPEAL BRIEF CONFERENCE REQUEST FOR REVIEW

Sir:

This paper includes the arguments accompanying a Pre-Appeal Brief Conference Request for Review and Notice of Appeal. The following is a concise recitation of **clear error** in the Examiner's rejections in this application. All claims stand rejected under 35 U.S.C. §102(e) as being anticipated by Kastelewicz, U.S. Patent Publication no. 2004/0153667. Applicant respectfully submits that one skilled in the art **clearly** would not interpret Kastelewicz as the Examiner has interpreted Kastelewicz, and even if the Examiner's interpretation is correct, Kastelewicz still does not disclose all elements of the claims.

The Examiner states the following:

> detecting at the first network element that the serving network element is out of service
>
> (paragraphs [0028]-[0029], [0049], [0052]; e.g., When the token timer runs out (i.e. the
>
> predetermined validity period of the token has been exceeded), then the communication terminal
>
> UE can no longer be used for any further IMS services; therefore, it is characterized as the
>
> serving network element is out of service);

Outstanding Office Action, page 3.

Because the UE can no longer be used for any further IMS services has no relationship with whether a S-CSCF in Kastelewicz is "out of service". Applicant implicitly defines what is meant by "out of service". See, e.g., paragraphs 11 and 12 in Applicant's published application 2007/0275710. The Examiner's interpretation of what is met by "detecting at the first network element that the serving network element is out of service" is clearly inapposite the Applicant's definition of a serving network element that is "out of service". This is true at least because the S-CSCF in Kastelewicz sends SIP 401 UNAUTHORIZED and other messages even when the UE can no longer be used for IMS services. See, e.g., paragraphs 47-55 of Kastelewicz. Therefore the S-CSCF is not "out of service" merely because the UE can no longer be used for any further IMS services.

Additionally, M.P.E.P. §2111 states the following: "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach", citing *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). It is respectfully submitted that one skilled in the art would not consider a S-CSCF in Kastelewicz to be "out of service" merely because a UE can no longer be used for IMS services. The S-CSCF is still "in service", especially since the S-CSCF in Kastelewicz sends SIP 401 UNAUTHORIZED and other messages even when the UE can no longer be used for IMS services. Again, see, e.g., paragraphs 47-55 of Kastelewicz.

For at least these reasons, the §102 rejections against the claims should be withdrawn.

Nonetheless, Applicant respectfully submits that Kastelewicz does not disclose all the features of claim 1. For instance, Kastelewicz does not disclose at least the subject matter of "detecting at the first network element that the serving network element is out of service", and "in response to detecting at the first network element that the serving network element is out of service and to determining that the type of the first message is a re-registration request, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service".

Kastelewicz appears to introduce a safe registration procedure for IMS. The initial registration includes two separate REGISTER messages SIP REGISTER1 and SIP REGISTER2 (messages 5 and 15 in FIG. 2 of Kastelewicz). As a response to the first register message, the S-CSCF (or IMS network) computes a token, which is sent to the terminal in a message called SIP 401 UNAUTHORIZED. Please note that it is said in [0029] of Kastelewicz that "This transport message is used in order to transport the token from the switching center S-CSCF to the terminal UE (arrows 11-13)." Please note also what is said in [0031] of Kastelewicz: "However, this token will subsequently be required for successful registration (sign-in) in the service network IMS." Thus, the message SIP 401 UNAUTHORIZED seems to be part of a normal successful registration process in Kastelewicz and this message is just used to transmit the token to the terminal.

That is, the SIP 401 UNAUTHORIZED message does not indicate a serving network element is out of service, particularly since this message originates from the serving network element (S-CSCF, the Serving Call Session Control Function; see paragraph [0019] of Kastelewicz). If the S-CSCF is "out of service", then how does the S-CSCF in Kastelewicz create the 401 SIP UNAUTHORIZED message?

Also, Kastelewicz describes a re-registration process starting in [0047]. The token may correspond to a timer that runs out. That is, there is a validity period associated

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with the token in Kastelewicz. See paragraphs 47, 48 from Kastelewicz. Kastelewicz goes on to describe a number of scenarios that might occur. In none of these scenarios is the S-CSCF in Kastelewicz out of service.

Applicant will examine these scenarios and show that at no point is the S-CSCF out of service and if the S-CSCF is "out of service", the subject matter of independent claim 1 is still not met.

Kastelewicz introduces two conditions under which an existing token whose token timer has not yet expired is normally replaced by a new token. See paragraphs 49-51 of Kastelewicz. It is clear that the S-CSCF is not "out of service" in paragraph 52 of Kastelewicz, as the S-CSCF is sending a message. It is clear that the S-CSCF in Kastelewicz in paragraph 54 is not "out of service" in this section, as the S-CSCF uses a new token and performs the steps described in FIG. 2 of Kastelewicz in order to perform IMS user authorization. It is clear that the S-CSCF in paragraph 54 of Kastelewicz is not "out of service" in this section, as the S-CSCF responds with a SIP 200 OK message to the UE. It is clear that the S-CSCF in paragraph 55 of Kastelewicz is not out of service in this section, as the S-CSCF erases the token and then performs the steps of FIG. 2.

Thus, in all of the disclosed scenarios in Kastelewicz, the S-CSCF takes affirmative steps to respond to a UE or takes other action, and therefore the S-CSCF is not "out of service", contrary to the Examiner's interpretation.

Furthermore, independent claim 1 recites "in response to detecting at the first network element that the serving network element is out of service and to determining that the type of the first message is a re-registration request, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service". If the Examiner's argument is correct that the token time has run out and therefore the "serving network element" is "out of service", then there should be some message sent from a "first network element" in Kastelewicz that includes "an indication that the serving network element is out of service". The SIP 410

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UNAUTHORIZED message appears to contain a token and does not appear to contain "an indication that the serving network element is out of service".
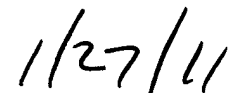
Moreover, the Examiner has not clearly elucidated which element in Kastelewicz is the "first network element" and which is the "serving network element". The Examiner's argument appears to suggest that the S-CSCF is both the "first network element" and the "serving network element". (Certainly the I-CSCF in Kastelewicz does not appear to determine that the token has expired.) But this would mean in order to meet the subject matter of "detecting at the first network element that the serving network element is out of service", the S-CSCF would have to detect that itself is out of service. How would this be possible? Further, claim 1 recites "transmitting the first message from the first network element to a serving network element". If the S-CSCF is both the "first network element" and the "serving network element", then how would the S-CSCF transmit the first message from itself to itself?

For at least these reasons, claim 1 is patentable over Kastelewicz. Because claim 1 is patentable, all other independent and dependent claims are also patentable.

Respectfully submitted:

_____
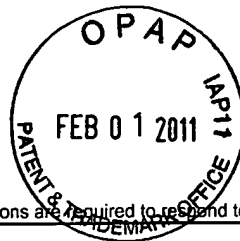Robert J. Mauri
Reg. No.: 41,180

1/27/11
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
800.0105.U1(US)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _January 27, 2011_ Signature _Gail Conway_ Typed or printed name _____ **Gail Conway**	Application Number 10/581,207	Filed November 9, 2006
	First Named Inventor Georg Mayer et al.	
	Art Unit 2617	Examiner Timothy X. Pham

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number _____ **41,180**

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

_____
Signature

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Typed or printed name

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Telephone number

January 27, 2011
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of ___ forms are submitted.